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IN THE

Supreme Court of the United States,

OCTOBER TERM, 1934.

No. 254.

PARAMOUNT PUBLIX CORPORATION,

Petitioner,

vs.

AMERICAN TRI-ERGON CORPORATION,

Respondent.

MEMORANDUM FOR RESPONDENT RELATING TO DECISIONS OF THE SUPREME COURT OF GERMANY AND INFERIOR GERMAN COURTS IN RESPECT OF GERMAN PATENT NO. 368,383 CORRESPONDING TO THE UNITED STATES PATENT NO. [illegible] HERE IN SUIT.

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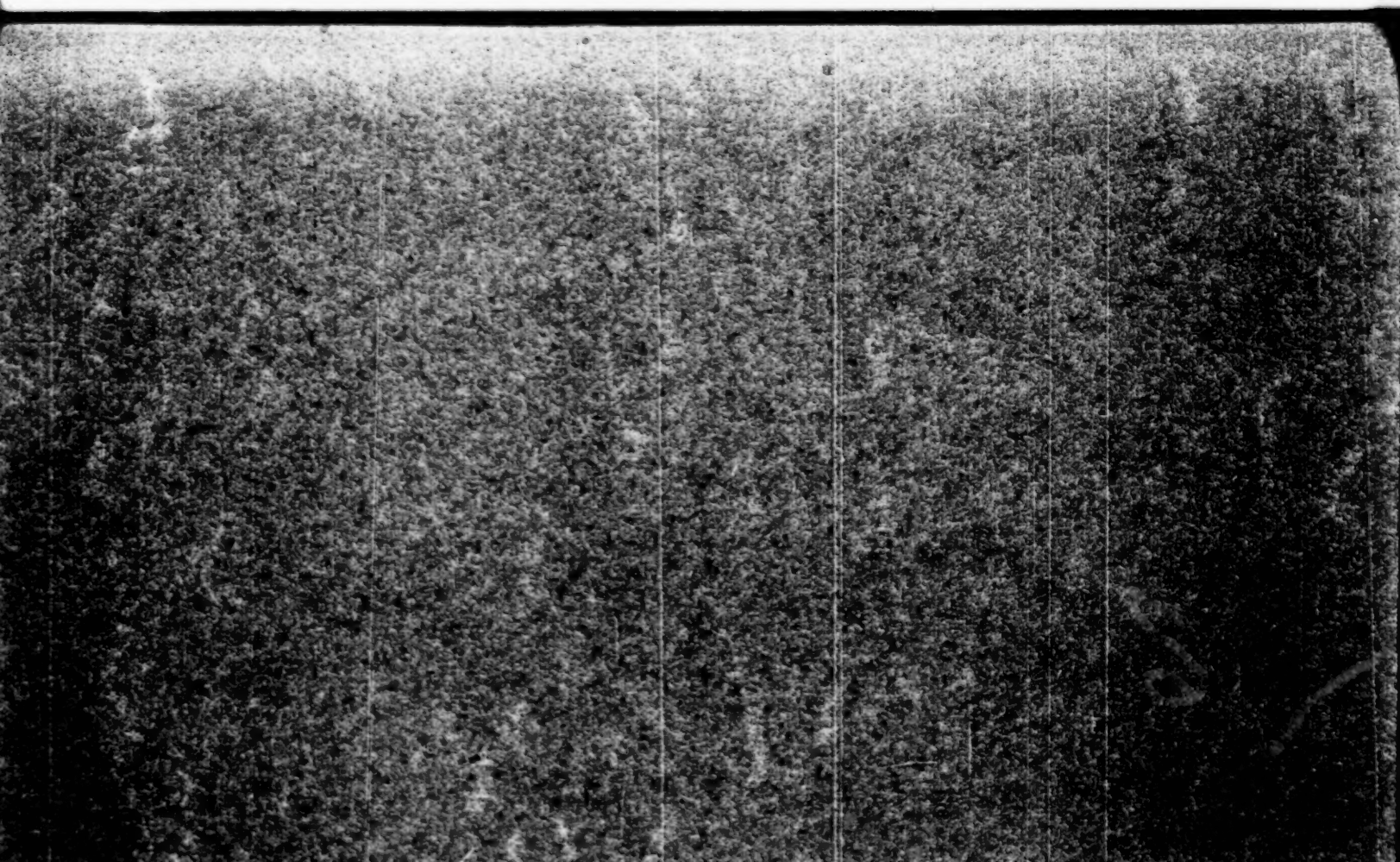

Supreme Court of the United States

OCTOBER TERM

PARAMOUNT PUBLIX CORPORATION, Petitioner. vs. AMERICAN TRI-ERGON CORPORATION, Respondent.	No. 254

MEMORANDUM FOR RESPONDENT RELATING TO DECISIONS OF THE SUPREME COURT OF GERMANY AND INFERIOR GERMAN COURTS IN RESPECT OF GERMAN PATENT NO. 368,383 CORRESPONDING TO THE UNITED STATES PATENT NO. 1,825,598 HERE IN SUIT.

We respectfully call to the attention of the Court the recent decision (December 22, 1934) of the Supreme Court of Germany and the decisions of the lower German courts respecting the German patent which corresponds to the patent here in suit, certified copies of these decisions having come to hand since the filing of Respondent's Brief herein. We have had these decisions translated with all possible speed consistent with accuracy by the Librarian of the Applied Science Library of Columbia University. Copies of the translations and photostats of the original certified German texts have been deposited

with the Clerk of this Court and served on petitioner's counsel.

It appears from the decisions, that the action was brought by a film producer and a film laboratory for a declaratory judgment that certain methods employed by them of recording sound and pictures on separate films, separately developing them, and then printing them on a single positive are not infringements of the Vogt, *et al.*, German patent No. 368,383.* Each of the courts decided that the methods used by the plaintiffs constituted infringements of the patent.

It is not our understanding that the issue of validity was involved.

These decisions of the German courts are chiefly interesting for their findings of fact with respect to the most important of the prior art patents referred to by the petitioner-defendant in the case at bar. Based upon these findings, the ten judges of the three courts which passed on the matter, were unanimous in deciding that the German patent is entitled to broad scope and protection.

While recognizing the difference between German and American law applicable to patents we think the following statements in the decisions of the Kammergericht and of the Reichsgericht, finding invention over the art of composite photography and the disclosures of Bullis and Craig, are worthy of repetition here.

From the decision of the *Kammergericht*, see pages 50, 51 of the translation:

> "This material distinction between a combined picture film and a sound and picture film, where the sounds are photographically-recorded, lies particularly in the fact that a reproduction of the sounds, free

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* This German patent is in evidence as Deft.'s Ex. L and is printed at R. page 960, translation at R. page 961. The application for the United States patent here in suit (R. p. 475) is a literal translation of the application for the said German patent, see R. pages 578-583.

from any distortion, is only possible if the darkening of the sound lines on the sound print produces changing conditions of light, which exactly correspond to the changing conditions of light during recording, whereas, naturally other instructions have to be heeded for the suitable darkening of the picture print. For this reason alone the Plaintiffs' view cannot be admitted as correct, that the transfer of the expedients known [usual] for the production of silent films to the production of a sound-picture film, according to the established facts stated above in the patent specification 368,383, were so obvious for the average expert, that no further invention was needed for it (to effect it). The contrary is confirmed by the propositions made by Bullis and Craig, which doubtless most resemble the proposition of the patent specification 368,383, and which, nevertheless, were not able to accomplish the instructions given solely in patent specification 368,383 as characterized above. For the very reason that the numerous prior publications and other propositions on the state of the art presented by the Plaintiffs did not result in the solutions, so simple in practice, which first made possible the production of really serviceable sound-picture films, the progress from the state of the art at the time of the filing of the application for Patent 368,383 has to be considered, in contrast to the Plaintiffs' view, as an inventive achievement worthy of protection. Accordingly the protection of Patent 368,383 has to be extended to these instructions. There again the Plaintiffs cannot rely successfully on the decision of the United States District Court submitted by them, especially as the Defendant has proved with correct reasoning, that the decision proceeds obviously from principles of patent law quite different from those applicable under German law."

From the decision of the *Reichsgericht*, see page 60 of the translation:

"But the Kammergericht rightfully considered the entire contents of the patent specification, in order to ascertain therefrom what problem the patent solved. From this it became evident that the new

process can only be achieved when the positive film is completed, and that the inventor by no means wanted to alter a part of an already known process, but rather to make known for the first time a serviceable process by which prints with undistorted sound sequences could be achieved. From this it is evident that the patent specification places under protection a combined process from the beginning of recording to the completion of printing, the uniform technical success of which [process] is assured, and that therefore the combination must be protected in its entirety, inasmuch as it is new in itself; from which it is of no consequence whether individual parts of the process were already previously known."

and at page 61 of the translation:

"Upon a careful examination of the description of the patent it appears, however, that all parts of the process are dealt with there. Even though, then, only one part is treated exhaustively and the patent specification is otherwise brief, because the process offers no material difficulties, it does not follow therefrom that the whole process of production cannot be covered by the protection. For the uniform technical success [result], which is the chief point, was a positive film which, as the Kammergericht points out, presented picture sequences and photographed sound sequences in an arrangement side by side, which has so far proved serviceable; and this result was in no way assured after the separation of the negatives, as long as the instructions of the patent were not followed, which, in spite of its relative simplicity, had been up to now neither set out nor applied. In this way, the Kammergericht establishes the uniform technical success, thus obtaining the basis for the determination of the inventive idea, both without evident legal error."

The decisions of the German Courts appear at the following pages of the translation.

District Court	Decision	page 1
Kammergericht	"	" 16
Reichsgericht	"	" 54

For convenience of reference we here indicate the pages of the translation at which the following matters of interest in the case at bar are discussed by the German courts.

Bullis
- District Court 6, 12
- Kammergericht 33, 37, 47–50
- Reichsgericht 63

Craig
- District Court 5, 11
- Kammergericht 33, 39, 47–50
- Reichsgericht 63–65

Greensfelder
- Kammergericht 33, 34, 47–49

Single Film System
- Kammergericht 37, 47–49
- Reichsgericht 63

Composite Printing
- District Court 13
- Kammergericht 34

Reimer
- District Court 5, 11
- Kammergericht 31–33, 47, 48
- Reichsgericht 62

Messter
- Kammergericht 33–35, 47, 50

Downing
- Kammergericht 33, 34, 36, 47, 50

Respectfully submitted,

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